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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/044,304	10/25/2001	Andreas W. Dreher	OPH.004A	6808

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EXAMINER

STULTZ, JESSICA T

ART UNIT	PAPER NUMBER
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2873

DATE MAILED: 03/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/044,304

Applicant(s)

DREHER, ANDREAS W.

Examiner

Jessica T Stultz

Art Unit

2873

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 1,2 and 9-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 3-8 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6. 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-2, and 9, drawn to method of making a lens, classified in class 351, subclass 177.
- II. Claims 3-8, drawn to lens, classified in class 351, subclass 159.
- III. Claims 10-11, drawn to a method of using a lens, classified in class 351, subclass 178.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the process as claimed can be used to other and materially different product. Specifically the process of making a lens in Invention I does not disclose making a lens with an area of constant index of refraction and at least a second area of varying index of refraction.

Inventions II and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product can be used in a materially different process of

using the product. Specifically the lens of Invention II can also be used to correct distant vision of a patient.

Inventions I and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not related because they have different functions. The inventions of Group I produce a lens and the inventions of Group II correct retinal dysfunction.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for and one group is not required for any other group, restriction for examination purposes as indicated is proper.

During a telephone conversation with Joseph Mallon on March 5, 2003 a provisional election was made without traverse to prosecute the invention of II, claims 3-8. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-2 and 9-11 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Information Disclosure Statement

The information disclosure statement filed in this case fails to comply with 37 CFR §1.56(b), which states that information is material to patentability, which it is **NOT CUMULATIVE** to information already of record or being made of record in the application.

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Applicant has cited almost a hundred references for consideration. The examiner believes that the thick stack of references for consideration is largely cumulative and, therefore, based upon the large number of references cited, the initialed references have been considered in a cumulative manner.

Drawings

The drawings are objected to for minor informalities. The proposed drawing changes are described in the attached form number 948. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4 and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically regarding claims 4 and 6, it is unclear as to whether the term “of a patient” defines a limitation for the claim since the lens is not previously disclosed specifically as a lens as an ophthalmic lens, it should be more positively claimed as an ophthalmic lens in independent claim 3. In claim 6, applicant further discloses a “first discrete gazing angle”, however, the lens was not previously disclosed as being an ophthalmic lens and therefore would not necessarily have a “gazing angle”. For purposes of examination it is assumed that the lens is an “ophthalmic lens”, however it is suggested that the term “lens” be defined more specifically as an “ophthalmic lens”.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 3, 4, and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Guilino et al.

Specifically regarding claims 3 and 4, Guilino et al discloses a lens comprising a first area of constant index of refraction (Column 10, lines 20-43, wherein the area of constant index of refraction is bordered by lines “S₁ and S₂” of the ophthalmic lens, Figure 2a); and at least one second area having a varying index of refraction along an optical axis of a patient (Column 10, lines 20-43, wherein the refractive index of the lens varies in the hatched region of Figure 2a and varies according to the coordinate “z” along the optical axis of the beam).

Regarding claim 7, it would have been inherent from Guilino et al that the lens disclosed above further include the first area corrects for the distant vision and the second area corrects for near vision of the patient, this being reasonably based upon it is being well known that varifocal and progressive lens as the claimed contact lens is disclosed as in Guilino et al (Column 4, lines 22-29) correct for both near and distant vision (Shown in Figures 1 and 2a, wherein the upper region, including the constant region, would correct for distant vision and the lower region, including the variable section, would correct for near vision).

Claims 3, 4, and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Gupta et al.

Regarding claims 3 and 4, Gupta discloses a lens having a first area of constant index of refraction (Column 1, line 51 to Column 2, line 15, wherein one of the zones has a “specified index of refraction”, Figures 1 and 2); at least one second area having a varying index of refraction (Column 1, line 51 to Column 2, line 15, wherein one of the zones has “an index continuously variable”, Figures 1 and 2); and further wherein the second zone i.e. the continuously variable zone, is located along an optical axis of the lens (Column 1, line 51 to Column 2, line 15, wherein both embodiments disclose the center zone as a zone having a continuously variable index, Figure 1 and 2).

Regarding claim 7, the embodiment of Figure 2 discloses a lens with five zones, the end zones and the center zone as zones of constant refractive index with the zones between having a variable refractive index (Column 2, lines 1-15, Figure 5). Furthermore, since the lens is a multifocal lens, apparently the upper zones are for distant vision correction, the lower zones are for near vision correction and the center portion providing intermediate correction. Therefore, based upon the broadness of claim 7, the uppermost zone of constant index of refraction can be considered as the distant vision correction zone and the lower zone of variable index of refraction (between the lowermost zone and the center zone) can be considered as the near vision correction zone.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5, 6, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gupta et al in view of Gupta et al in view of Magnante.

Regarding claim 5, Gupta et al discloses a lens as disclosed above in claim 3, and further discloses that the lens have a third area having varying index of refraction (Column 2, lines 1-15, wherein there are two areas having a variable index of refraction, Figure 2), but does not specifically disclose that this third area correct higher order aberrations. Magnante teaches of making a contact lens with a varying index of refraction to correct higher order aberrations (Column 18, line 65-Column 19, line 4). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made for third area of varying refractive index correct for higher order aberrations since Magnante teaches of making a contact lens with a varying index of refraction to correct higher order aberrations.

Regarding claim 6, Gupta et al discloses a lens as disclosed above in claims 3 and 4, wherein the second area lies along an optical axis and a first area which lies along the optical axis but does not specifically disclose that the second area correct higher order aberrations for a first discrete viewing angle and that the first area corrects lower order aberrations for a second discrete viewing angle. Magnante teaches of making a contact lens with a varying index of refraction to correct higher order aberrations (Column 18, line 65-Column 19, line 4) and it is well known in the art that contact lens of constant refractive indices correct for lower order aberrations. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made for second area of varying refractive index correct for higher order aberrations since Magnante teaches of making a contact lens with a wherein a second area of varying index of refraction corrects higher order aberrations for a first discrete viewing angle and

that the first area corrects lower order aberrations for a second discrete viewing angle since Magnante teaches of making a contact lens with a varying index of refraction to correct higher order aberrations and it is well known in the art that contact lens of constant refractive indices correct for lower order aberrations.

Regarding claim 8, Gupta et al discloses a lens as disclosed above in claim 3, and but does not specifically discloses that the second area of the lens corrects higher order aberrations. However, Magnante teaches of making a contact lens with a varying index of refraction to correct higher order aberrations (Column 18, line 65-Column 19, line 4). Therefore it would have been to one having ordinary skill in the art at the time the invention was made obvious for second area of varying refractive index correct for higher order aberrations since Magnante teaches of making a contact lens with a varying index of refraction to correct higher order aberrations.

That part of the claim stating “resulting from dysfunctional retinal tissue” goes to the intended use of the optical device. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).


Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Due to the broad nature of the claims, there are numerous references that read on with the independent claim. For example, Suda et al, Blankenbecler et al, and Futhey et al are cited as reading on with the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessica T Stultz whose telephone number is (703) 305-6106. The examiner can normally be reached on M-Th 7:30-5, and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Epps can be reached on 703-308-4883. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7722 for regular communications and 703-308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.



Jessica Stultz
March 20, 2003



JORDAN SCHWARTZ
PRIMARY EXAMINER